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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,319	07/06/2001	Priscilla M. Tramontana	PPC-800	6598
27777	7590	02/13/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			DELACROIX MUIRHEI, CYBILLE	
			ART UNIT	PAPER NUMBER
			1614	
DATE MAILED: 02/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/900,319	Applicant(s) TRAMONTANA, PRISCILLA M.	
	Examiner Cybille Delacroix-Muirheid	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11, 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claims 20-23 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodiguel, WO 97/38738 in view of Iyer et al., 5,939,050 and Romano et al. WO 97/25106.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

The following is responsive to Applicant's request for continued examination and the amendment received Nov. 24, 2003.

Claims 1-5 and 12-19 are cancelled. No new claims are added. Claims 6-11 and 20-23 are currently pending.

Claim Objection(s)

Claims 22, 23 stand objected to because of the following informalities: claims 22, 23 still depend upon cancelled claim 19. Appropriate correction is required.

Response to Arguments

Applicant's arguments in the amendment received Nov. 24, 2003 traversing the previous claims rejection under 35 USC 103(a), set forth in paragraphs 6-8 of the office action mailed Nov. 25, 2002 have been considered but are, respectfully, not found to be persuasive.

The rejection is maintained essentially for the reasons given previously in the office action mailed Nov. 25, 2002 with the following additional comment:

Applicant argues that Bodiguel purports to disclose a sanitary napkin containing one or more antiseptics of natural origin. Such antiseptics may be chosen from essential oils as geranium, lavender or citronella. Furthermore, the sanitary pad may contain 0.2 mg to 20 g of antiseptic.

Concerning the Iyer and Romano references, the Applicant maintains that Iyer and Romano appear not to disclose as much as the Examiner asserts. Applicant submits that "it is not seen where either" reference discloses the use of essential oils, alone, as effective agents, as claimed by Applicant. The Examiner still has not met her burden of establishing obviousness by not providing any guidance as to where the asserted facts can be found in the references.

Next, Applicant contends that it remains to be seen where in the references there is disclosure of each essential oil independently having antimicrobial as well as aromatic properties. Nor has any evidence in the record been located to support such a factual assertion. Additionally, addressing the Examiner's remarks with respect to the use of "comprising" language, Applicant submits that the Examiner's comments are moot since claim 20, as amended, recites "consisting essentially of" language. Finally, Applicant argues that one of ordinary skill in the art of sanitary napkins would not consider solutions for killing bacteria in the oral cavity or cleaning floors.

Said arguments have been considered but are not found to be persuasive.

Applicant's arguments that (1) there is no teaching in the Iyer and Romano references of the use of essential oils alone as active agents and (2) that it remains to be seen where in the references there is disclosure of each essential oil independently

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having antimicrobial as well as aromatic properties are noted. However, the Examiner respectfully submits that it may be fairly inferred from the teachings of the references that each essential oil independently has antimicrobial as well as aromatic properties. Please see the abstract of Romano et al., where it is disclosed that the compositions contains "an antimicrobial active of essential oil." Please also see Iyer, col. 3, lines 11-27, where Iyer discloses that the antibacterial compositions contain an "antimicrobial agent" selected from the list of essential oils taught at lines 15-27. Although there is no teaching *ipsis verbis* that the essential oils "alone" are effective antimicrobial agents, such a conclusion may be fairly inferred from the disclosures of Iyer and Romano. The inventions described in Romano and Iyer may be based on a combination of antimicrobial agents. Yet, this does not negate the fact that the essential oils are disclosed as being antimicrobial agents.

With respect to claim 20, which now recites "consisting essentially of" language, according to MPEP 2111.03, "the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 90 USPQ 461, 463 (CCPA 1976) (emphasis in original). "A consisting essentially of claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising' format." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also Atlas Powder v. E.I. duPont de Nemours & Co., 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); In re Janakirama-

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Rao, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); Water Technologies Corp. vs. Calco, Ltd., 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). In this case, Applicant has not shown how the introduction of the additional components in Iyer and Romano would change the characteristics of the claimed invention.

Additionally, Applicant’s argument that one of ordinary skill in the sanitary napkin art would not turn to art pertaining to cleaning solutions and antibacterial compositions for the oral cavity to arrive at the claimed invention is noted. However, it has been held that “recognition of a problem confronted by the inventors may be an important factor to consider under 35 USC 103.” In re Wright, 6 USPQ 2d 1959 (Fed. Cir. 1988). The Examiner respectfully submits that if the problem confronted by Applicant in the instant invention is malodor and the presence of microbes during the use of a sanitary napkin, then it seems reasonable for one of ordinary skill in the art to turn to art pertaining to antibacterial compositions for a solution.

Finally, in addressing the argument that the Examiner still has not met her burden of establishing obviousness by not providing any guidance as to where the asserted facts can be found in the references, the Examiner respectfully maintains that “obviousness is a legal conclusion based on facts.” Please see Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ 2d 1593, 1595 (Fed. Cir. 1987). Based on the

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facts disclosed by the prior art, the Examiner respectfully maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sanitary napkins of Bodiguel to include the antimicrobial and aromatic essential oils disclosed by Iyer and Romano because Iyer and Romano suggest, i.e. it can be fairly inferred, that such essential oils have a pleasant odor and are effective antimicrobial agents, and one of ordinary skill in the art would reasonably expect the resulting sanitary napkins to have antiseptic/antimicrobial properties as well as to suppress or eliminate any malodors associated with the use of a sanitary napkin. Such a modification would have been motivated by the reasonable expectation that the resulting sanitary napkins, during use, would prevent unwanted microbial growth while simultaneously providing pleasant aromas.

It is for these reasons that the rejection is maintained.

Conclusion

Claims 6-11, 20-23 stand rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is 571-272-0572. The examiner can normally be reached on Mon-Fri from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (571) 272-0584. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CDM

Feb. 7, 2004


Cybille Delacroix-Muirheid
Patent Examiner Group 1600